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PATENT TRADEMARK OFFICE

Docket No: 3489/1F153

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Shirley RODAWAY; John FINNI; Karl-Heinz OTT;  
Lurokin SAROKIN

Serial No.: 09/498,949

Art Unit: 1652

Confirmation No.:

Filed: February 4, 2000

Examiner: Christian L. Fronda

For: TRYPTOPHAN SYNTHASE AS A SITE OF HERBICIDE ACTION

RESPONSE

Hon. Commissioner of  
Patents and Trademarks  
Washington, DC 20231

September 5, 2001

Sir:

This is in response to the Office Action dated July 5, 2001 received in the above-captioned application.

The Examiner has required restriction under 35 C.F.R. § 1.121 to one of sixteen groups of claims. Applicants respectfully traverse the restriction requirement.

However, in order to be fully responsive to the official action, Applicants elect the claim of Group II, claim 9, drawn to an inhibitor of tryptophan synthase identified by the method of claim 1, for examination in this application.

The Examiner states that Groups I and II are related as process of making and product made, however also states that the claims of Groups I and II are independent and distinct from one another.

First, Applicants note that the Examiner states that the inhibitors of Group II are distinct from the method claim of Group I because the inhibitor may be made by another and materially different process such as by homology modeling. Applicants disagree with this distinction.

Applicants submit that restriction is not appropriate between Groups I and II because the product of the claim of Group II, i.e., an inhibitor of tryptophan synthase, specifies that it is made by, i.e., identified by, the method of the claim of Group I. Thus the product of Group II as claimed specifically depends on the method of claim 1, Group I. Section 806.01 of the MPEP provides:

In passing upon questions of . . . restriction, it is the claimed subject matter that is considered and such claimed subject matter must be compared in order to determine the question of distinctness and independence.

In the subject application, the product of Group II and process of making the product of Group I are not distinct because the claimed product is necessarily produced by the claimed method. Because the claim of Group II depends upon and is specifically

tailored to an inhibitor of tryptophan synthase identified by the method of the claim of Group I, the two groups of claims are linked. The product and process of making the product are therefore not distinct and should be examined in a single application.

Favorable reconsideration of the restriction requirement is earnestly solicited.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Raina Semionow", is written over a horizontal line.

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